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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/883,002	SHAW ET AL.
	Examiner	Art Unit
	William M Pierce	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 December 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-18 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

 1. Certified copies of the priority documents have been received.

 2. Certified copies of the priority documents have been received in Application No. _____.

 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

WILLIAM M. PIERCE
PRIMARY EXAMINER

DETAILED ACTION***Claim Rejections - 35 USC § 112***

Claims 4-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-7 remain as set forth in the previous office action. One cannot determine if "control lines" and "power lines" are being claimed in combination. While they are referred to as part of the function of a means-plus-function recitation, one cannot determine if they are being positively recited. For example, the control lines between the control means and the basketball goal should be positively recited prior to referring to them in a statement of function. Like problem exists with respect to claims 16 and 17. Claims 10-12, 14 and 15 remain inapt as set forth in the previous office action since one cannot determine the metes and bound of the claims. These claims are narrative and do not positively recite structure. Examiner's position with respect this issue is clearly set forth in MPEP where the term "adapted to" is considered to be language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Claim Rejections - 35 USC § 103

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman in view of Kesling and further in view of matters considered old and well known as set forth in the previous office action and below in response to applicant's remarks.

Response to Arguments

Applicant's arguments filed 12/26/02 have been fully considered but they are not persuasive.

Examiner's position with respect to the issues under 35 USC 112, second paragraph is set forth in the grounds for rejection above.

Applicant argues the rejection under 103 stating that the "suggestion...must be found in the prior art". This is true. In the instant case, the prior art is game courts, game equipment and areas having multiple game courts and equipment use therein. Berman is applied as an example of divisions used between a plurality of courts in an enclosure and what is already admitted as prior art by the applicant. True he alone does not "teach or suggestion that would motivate a skilled artisan to practice the instantly claimed sports enclosure" applicant's claimed invention (as pointed out by applicant at bottom of pg. 6). However, this statement is made without an entire consideration for obviousness and motivation as it applies to 35 USC 103. The word "motivation" or a word similar to "motivation" does

Art Unit: 3711

not appear in 35 U.S.C. § 103(a). While a finding of "motivation" supported by substantial evidence probably will support combining teachings of different prior art references to establish a *prima facie* obviousness case, it is not always necessary. For example, where a claimed apparatus requiring Phillips head screws differs from a prior art apparatus describing the use of flathead screws, it might be hard to find motivation to substitute flathead screws with Phillips head screws to arrive at the claimed invention. However, the prior art would make it more than clear that Phillips head screws and flathead screws are viable alternatives serving the same purpose. Hence, the prior art would "suggest" substitution of flathead screws for Phillips head screws albeit the prior art might not "motivate" use of Phillips head screws in place of flathead screws. What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a §103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art which would have rendered obvious the claimed subject within the meaning of § 103(a). *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637(Fed. Cir. 1998) (there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant); *In re Gartside*, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778(Fed. Cir. 2000) (the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a teaching or motivation to combine prior art references); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.* 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629(Fed. Cir. 1996) ("there must be a reason, suggestion, or motivation *** to combine [the teachings of] *** references ***"); *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999) (there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention; the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references). In the instant case the examiner has supported his reasoning by sufficient legal rational such as *In re Venner*, *In re Jacob*, *In re Bozek* and by providing specific examples. Hence, the rejection an examiner's position is deemed proper.

Applicant more specifically argues claim 18 at the top of pg. 7. However, this argument merely amounts a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The grounds for rejection is clear that enclosures having multiple divided playing areas are known. Further these type of enclosures where "the basketball backstops

Art Unit: 3711

can be positioned for play or folded away for storage are known as admitted by applicant on pg. 1, ln. 14). Using motors, buttons, electrical control lines and relays are rudimentary to the automation of a manual activity and combined in a way that would have been obvious to one of ordinary skill in the art wishing to make the tasks of manually raising and lowering curtains and backboards automatic. Note that it has been held that skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962)).

Examiner does not agree with applicant's interpretation of *In re Venner*. As in *Venner*, the only thing missing from the prior art of basketball enclosures when compared with the instant invention is the limitations drawn to the automation of raising and lowering the goals and divisions. The use a first voltage for a control signal is known and the use of relays between the control signal and motors that operate the automation activity is so notorious the examiner will not belabor the issue. The limitations recited in applicants claims are merely an application of relays for what they are were intended to be used for and are not considered a patentable advance.

Examiner does not agree that the same results are not accomplished by the mere automation of raising and lowering the basketball goal. Surely applicant is not the inventor of the use of security codes, keys or passwords in order to operate a device.

Kesling is representative of the a system used to automate manual devices. One skilled in the art wishing to automate a manual device such as a basketball goal or court division would surely consider the teachings of *Kesling*.

In no way can the art of automation be considered an "esoteric technology". Methods of remotely controlling and automating devices are well understood by many and is not considered an art for the chosen few. Hence, one must further consider that it has been held that such matters of common knowledge and common sense of the person of ordinary skill in the art does not distinguish over the prior art. (See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

The rejection set forth above is clearly permissible as a matter of law and practice. The use of official notice is well established. When the rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (Board properly took judicial notice that "it is common practice to postheat a weld after the welding operation is completed" and that "it is old to adjust the intensity of a flame in accordance with the heat requirements."). See also *In re Seifreid*, 407 F.2d 897, 160 USPQ 804 (CCPA 1969) (Examiner's statement

Art Unit: 3711

that polyethylene terephthalate films are commonly known to be shrinkable is a statement of common knowledge in the art, supported by the references of record.). Clearly it has been recognized that the examiner should not be obliged to spend time to produce documentary proof if the knowledge is of such notorious character that official notice can be taken and that it is sufficient so to state. *In re Malcolm*, 129 F.2d 529, 54 USPQ 235 (CCPA 1942).

Lastly, all the results obtained by applicant's invention are to be expected when a manual device is automated. There exists no evidence to the contrary. Using a low voltage to the control device is routine. A simple remote starter on an automobile (i.e. ignition switch) uses low voltage that is routed to relays that allow high voltage to turn the starter motor. Hence, the examiner is unpersuaded that any unexpected results exist.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.

Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is CustomerService3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE
PRIMARY EXAMINER